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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/673,273	01/16/2001	Stephen Andrew Howell	CE01538R	3549

7590 02/24/2005

Jonathan P Meyer
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Intellectual Property Section Law Department
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Schaumburg, IL 60196

EXAMINER

CRAVER, CHARLES R

ART UNIT	PAPER NUMBER
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2682

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/673,273	Applicant(s) HOWELL ET AL.	
	Examiner Charles R Craver	Art Unit 2682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7 and 9-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7 and 9-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-7, 9-14, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Messiet, US Pat 5,875,404 in view of Martineau, US Pat 5,915,226.

Claims 1, 5, 7, 11, 13, 14: Messiet discloses a data carrier system and method comprising a first and second SIM card 1 and 2 couplable to a communications device 5, the second couplable in preference to the first (col 2 lines 25-47), wherein inherently power is provided during a determined time (via a battery) and wherein the second SIM may be decoupled from the device (col 2 line 66-col 3 line 60), thereby reverting to the first SIM for executing a task using said SIM, using information in said SIM (phone numbers, identifiers etc, i.e. calling or sending a short message to a stored number).

Messiet fails to disclose that the first SIM is selectively couplable to the device, but rather is affixed semi-permanently. However, Martineau discloses in a similar device using two SIM cards, that the first card may be permanent as well, or may be removable like the second (col 5 lines 18-54). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Messiet to allow the removal of the first card in order to allow for easier upgrades i.e. getting a card with

more memory for numbers and messages etc and provide a more 'modern' device, see Martineau col 1 lines 61-67.

Lastly, providing power to a device for a predetermined time after a command to extinguish power to the device was a commonplace feature at the time of the invention, as evidenced by a cellular phone (such as that taught by Martineau) which, when a power-off button is pressed, waits a predetermined time to cut power in order to save data. As such the examiner takes Official Notice of such a feature, asserting that one of ordinary skill in the art at the time of the invention would have sought to include such a feature in Messiet in view of Martineau in order to allow phonebook and address data etc. to be properly saved and not lost.

Claims 3, 4, 9: the use of a sleep mode in a cellular device was notoriously well-known at the time of the invention as well, and as such the examiner takes Official Notice of such a feature, asserting that one of ordinary skill in the art at the time of the invention would have found it obvious to add a sleep mode to Messiet in view of Martineau in order to save power. Further, updating information in a SIM such as the first carrier is a process which occurs in any SIM-based phone with a directory or saveable messages, such as that taught by Messiet or Martineau. **Claims 4, 10:** Messiet discloses that the first card may be substantially permanently in engagement with a means for receiving the card. Further, the main device may be powered down at any time by the user, which would include a time subsequent to updating information. **Claims 6, 12:** Messiet discloses that the first SIM may restrict outgoing calls, and has

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similar functions as the second SIM; as such, the sending of pre-recorded messages of Messiet are read as a call using SIM card information.

Claims 22, 23: the use of a mobile telephone as taught above in a vehicle or emergency (911) situations was commonplace in the art at the time of the invention (emergency calling features being mandated by government), and a car-cradle means and 911 calling means would have occurred to one of ordinary skill in the art as standard features or accessories for a cellular device. **Claim 24:** Martineau discloses a cellular telephone.

Claims 15-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Messiet in view of Martineau as applied to claims 1 and 7 above, and further in view of Siccardo et al, US Pat 6,115,605, newly cited.

Claims 15-18, 20-22: While disclosing applicant's invention of claim 7 above, Messiet in view of Martineau fail to disclose GPS location determining means as well as address means.

Siccardo discloses the utility of providing a GPS locating means to a cellular phone including a SIM smartcard such as that taught by the combination of Messiet in view of Martineau as shown above (col 8 lines 37-50), wherein the user may update address data determined by the GPS system (col 6 lines 49-61, col 8 lines 1-21).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add such a feature to Messiet in view of Martineau, as Siccardo discloses that such improves emergency call response.

Claim 19: Siccardo discloses emergency call use (col 3 lines 46-58).

Response to Arguments

Applicant's arguments filed 11-4-04 have been fully considered but they are not persuasive.

Regarding claims 1, 7, 23 and 24, the examiner upholds the rejection above. First, while e.g. independent claim 1 recites a series of steps, they are not disclosed as occurring in a particular order; for example, the use of the combined invention of Messiet and Martineau discloses the invention of claim 1, in such a case where a user may couple and decouple the second SIM to the device, use the device, and then power it down.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

(703) 872-9306 for both formal and informal/draft communications, labeled as such.

Hand delivered responses should be brought to Crystal Plaza II, 200

South 20th St, Arlington VA, first floor (receptionist).

Any inquiry concerning this or earlier communications from the examiner should be directed to examiner Charles Craver at (703) 305-3965.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vivian Chin, can be reached at (703) 308-6739.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at (703) 305-4700.


CHARLES CRAVER
PRIMARY EXAMINER

CC

C.Craver

February 22, 2005